



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kucera, et al.
Serial No.: 09/627,312
Filed: July 27, 2000

Docket No.: IR-2800(NBA)
Group Art Unit: 1773
Examiner: M. R. Jackson

For: "Two-Part Aqueous Metal Protection Treatment"

REPLY UNDER 37 CFR 1.111

Assistant Commissioner of Patents
Washington, DC 20231

Dear Sir:

Applicant replies to the Office Action mailed June 20, 2002. A separate paper containing a petition for extension of time and authorization to deduct the fee accompanies this reply. Attached herewith is a Declaration pursuant to 37 CFR 1.130 which disqualifies WO 99/37722 and WO 99/37713 as prior art. WO 99/37722 is the publication of now issued U.S. Pat. No. 6,383,307.

WO 99/37713 is the publication of now issued U.S. Pat. No. 6,476,119. These references have not been applied under 35 USC 102(b) and were commonly owned with the pending application at the time of filing of the pending application. These U.S. Patents have the same expiration date.

Disqualification of WO 99/37722 and WO 99/37722 as prior art for all purposes overcomes the rejections under 35 U.S.C. §§ 102(a) in parag. 9, paper no. 6, and the rejections under 35 USC 103(a) in parags. 10, 12 and 13 of paper no. 6.

Disqualification of WO 99/37722 and WO 99/37722 as prior art moots the rejection grounded in obviousness double patenting (Id., Parag. 13). That obviousness double patenting rejection was incorrectly stated as based upon U.S. P.N. 6,383,307 and WO 99/37722 which are one and the same disclosure.

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The terminal disclaimer attached herewith disclaims the term of the pending application beyond expiration of United States Patent No. 6,476,119, published as WO 99/37713, in accordance with the requirements of 37 CFR 1.130, and renders the rejection under obviousness double patenting as moot.

WO 99/37722 and WO 99/37713 are removed as prior art for their entire contents, as being directed to commonly owned subject matter in accordance with 37 CFR 1.130 by way of (1) showing of common ownership established on record and (2) establishing by declaration the fact that the inventor named in pending ser. no. 09/627,312 is the prior inventor of WO/9937722 and WO 99/37713 under 35 U.S.C. §104.

Removal of the rejections under 35 U.S.C. §§ 102(a) stated in (parag. 9, paper no. 6), and under 35 USC 103(a) stated in parags. 10, 12 and 13 is respectfully requested.

Rejection under 35 USC 112

Claims 6 and 7 were rejected in error. The rejection alleged that the term "coating forming component" that can encompasses a flexibilizer renders the claim indefinite. Applicant disagrees. What is error is taking the claim terms out of context and ignoring the element for which these specific elements are part of. The elements that render the claimed invention particularly pointed out as claimed are the two main components, of which flexibilizers can be part of each. These elements are

- (1) the aqueous metal treatment conversion coating component, and
- (2) the aqueous protective coating component.

The term ignored in claim 6 was the term "aqueous protective--" in connection with "coating component". The term ignored in claim 7 was

“aqueous metal treatment conversion coating in connection with “coating component”.

According to the specification (1) and (2) provide different functions, but can contain subcomponents like flexibilizers. The specification clearly sets forth what (1) and (2) embodiments can comprise. Embodiments of (1) and (2) that are flexibilizers themselves does not render claim 6 and 7 indefinite in view of claim 1.

Claim 6 recites that the “aqueous protective coating component” may further comprise a flexibilizer. The specification teaches embodiments of the aqueous protective coating component, such as a paint, or adhesive. See line 1, page 18. In these types of embodiments, the paint or adhesive may further be particularly described as containing a flexibilizer. Nothing indefinite is seen in light of the information provided the skilled person.

In claim 7, the aqueous metal treatment conversion coating can further comprise a flexibilizer.

The aqueous protective coating component, as well as the aqueous metal treatment conversion component also contains water. Water is not a flexibilizer. The rejection is in error in alleging that “coating forming component” recited together with “flexibilizer” renders the claims indefinite. Skilled person read claims from a point of practicality, and understands terms (1) and (2) by not taking them out of context in relation to further defining a component that can be included in them.

See line 28, page 18. Thus the Examiner is incorrect in alleging that the aqueous protective coating component must encompass a flexibilizer. The skilled person reading the specification, in view of claim 6 and 7 and claim 1 from which these depend, readily understands that the aqueous protective coating

component is the element that is distinguished from the conversion coating component. The skilled person is not confused by the fact that the aqueous protective coating component can "further comprise" a flexibilizer, and understands that the aqueous protective coating component recited in claim 1, does not necessarily contain a flexibilizer, but in claim 6, such is part of that component. Likewise in claim 7 for the aqueous metal treatment conversion coating component. Either of these components can contain a flexibilizer or be absent a flexibilizer.

Claims objected to a comma vs. semi-colon in claim 16; misspelling in claim 17, and comma in claim 18.

These objections are overcome by amendment to these claims below.

Please amend the claims as follows:

In line 4 of claim 8 after "organo-phosphonate acid", insert a comma.

In line 2 of claim 16, replace the comma after "aromatic nitrosulfonates" with a semi colon.

In line 2 of claim 17, replace "initrobenzenesulfonate"
with -dinitrobenzenesulfonate--.

In line 2 of claim 18, remove the comma after "comprises".

A clean copy of the changes to these claims is attached.

Respectfully Submitted,



M.B. Dearth

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Reg. No. 35,115

CERTIFICATE OF MAILING (37 CFR 1.8(a))

The person signing below hereby certifies that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date indicated below with the United States Postal Service in an envelope addressed to the Assistant Commissioner of Patents, Washington, DC 20231, with sufficient postage as first class mail (37 CFR 1.8(a)).

Printed name:

Alida McClark

(Signature of person mailing paper)



12/19/02

Date